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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,272	07/31/2003	Marc Charles Payne	881022-7	3765

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EXAMINER

SZUMNY, JONATHON A

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,272

Applicant(s)

PAYNE ET AL.

Examiner

Jon A Szumny

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5-8 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is the first office action for application number 10/631,272, Method and System for Temporary Attachment of a Container to a Vehicle, filed on July 31, 2003.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a bottle attachment device, classified in class 248, subclass 311.2.
- II. Claims 10-13, drawn to a method of temporarily attaching a container to an exterior surface of a vehicle, classified in class 224, subclass 400.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product could be used simply to store the container against the vehicle, and does not necessarily need to be used in actually removing and applying material from the container as specified in the method.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Brian Berliner on June 7, 2004 a provisional election was made without traverse to prosecute the invention of group I,

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claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Further, this application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: The attachment device of figures 2-5;

Species 2: The attachment device of figure 6;

Species 3: The attachment device of figure 7;

Species 4: The attachment device of figure 8;

Species 5: The attachment device of figure 9;

Species 6: The attachment device of figure 10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Brian Berliner on June 9, 2004 a provisional election was made without traverse to prosecute the invention of species 1, claims 1, 4 and 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2, 3, 5, 6, 7 and 8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

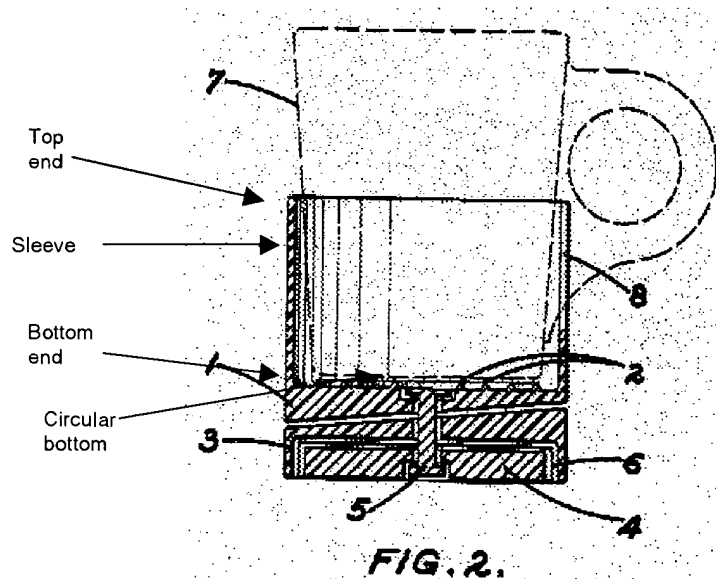
Domestic priority of application number 60/399,683 filed on July 31, 2002 is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent number 3,524,614 to Sorth in view of U.S. Patent number 6,305,656 to Wemyss.



Sorth '614 discloses an attachment device (above) comprising a holder (1), a magnet (4) that is connected to the holder (via 5) wherein the magnet is of sufficient strength. However, Sorth '614 fails to specifically teach a cushion to be connected to the magnet wherein at least a portion of the cushion is inherently adapted to be

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positioned between the magnet and an exterior surface. Nevertheless, Wemyss '656 divulges an attachment device (figure 2) including a magnet with a rubber cushion/boot (22 and 24, column 6, lines 3-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the magnet of Sorth '614 so as to have a rubber cushion/boot that could inherently be positioned between the magnet and an exterior surface so as to prevent a object being coupled with the magnet from being marred, in addition to providing for increased friction which would inherently provide for a superior coupling of the magnet and an exterior surface.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent number 3,524,614 to Sorth in view of U.S. Patent number 6,305,656 to Wemyss, and further in view of U.S. Patent number 4,844,400 to Jasmagy, Jr.

Sorth '614 in view of Wemyss '656 disclose the previously described invention wherein the holder is a cup with a sleeve connected to a circular bottom (above), wherein the sleeve has top and bottom ends, but fail to specifically teach the sleeve to be a conical sleeve with a top end having a greater diameter than a bottom end. Nevertheless, Jasmagy, Jr. '400 divulges an attachment device (figures 1-3) including a conical sleeve (12) having a top end with a diameter greater than that of a bottom end. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the sleeve of Sorth '614 in view of Wemyss '656 to be a conical sleeve with a top end with a diameter greater than that of a bottom end so as to allow for a greater number of various sized containers to be held in the holder of the attachment device.

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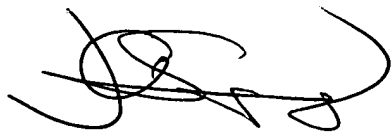
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Henry '514, Gladden '145, Rains '341, Moore, Jr. '632, Chun '798, Chu '097, Morgan '486 and Florey '439 divulge various attachment devices including sleeves and magnets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application and proceeding are assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read 'Jon Szumny', with a stylized flourish at the end.

Jon Szumny
Patent Examiner
Technology Center 3600
Art Unit 3632
June 10, 2004